

REMARKS/ARGUMENTS

Upon entering the above amendments to the claims, claims 58 and 95-109 will be pending in this application. Claims 58 and 60 have been amended claims 59 and 61-69 are canceled and claims 95-109 are new. The new and amended claims are presented to focus the claims on methods of inhibiting soluble epoxide hydrolase with particular cycloalkyl substituted ureas. Support for the present amendment is found in the specification and claims as originally filed, and more specifically in original claim 59. Applicants believe no new matter is present in any portion of the preliminary amendment and respectfully request that the amendment be entered for substantive examination. With regard to the assertion that reference to Tables in the claims do not meet the criteria of MPEP 2173.05(s); Applicants note that claims 1-57 and 70-94 are currently withdrawn and claims 59 and 61-69 are canceled.

The Examiner has requested restriction to one of 110 inventions. In response to the restriction requirement, Applicants provisionally elect to prosecute the invention of what appears to be Group 2 (claim 58, drawn to a compound of Group B). In response to the Examiner's request for an election of species, Applicants further elect the compound 1-adamantan-1-yl-3-(12-dodecanoic acid)-urea. The compound is described as compound 687 in Table 14. Claims readable thereon include claims wherein R^1 is C_5 - C_{12} cycloalkyl; P^1 is $-NHC(O)NH-$, P^2 is (CO_2R^2) , R^2 is H, n is 0, m is 1; and L^1 and L^2 is an substituted or unsubstituted C_2 - C_{12} alkylene.

Moreover, Applicants election is made with traverse. The Office alleges that there are 110 distinct inventions, though the compounds are structurally related. The Examiner alleges that the inventions are distinct as the process for using the product as claimed can be practiced with a materially different product (MPEP §806.05(h)). Under 35 U.S.C. § 121, there are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (1) the inventions must be independent or distinct as claimed; and

(2) there must be a serious burden on the examiner if restriction is not required (emphasis added). See MPEP § 803. Applicants submit that both these criteria are not met by the presently claimed invention.

Applicant respectfully submits that the standard for restriction was improperly applied and incomplete in this case, resulting in an inconsistent and inordinate number of inventions. In holding that the inventions are drawn to compounds having distinct structures from one another, the Examiner does not explain what he considers are the distinct structural elements or different classes of chemical compounds that result in Applicants' invention being divided into 110 separate inventions. The Applicants note that the Examiner has classified all the compounds in class 514, subclass 2. Instead of considering distinct structural features, the Examiner bases the restriction, in part, on the presence of compounds in the Tables of the application. The basis for this division is unclear and seemingly ignore chemical restriction practice as the same compound is often present in different groupings (Compound 632 in Table 1 and Table 9 is classified in Groups A and F, respectively) and some compounds are not included in any Group (see e.g. compounds of Tables 3 and 15). In the absence of a reasoned basis for the finding that sub-Groups A-J have distinct structural elements, the holding that each of the Groups constitutes groupings of separate inventions is without merit.

Applicants note that the claims of Groups A, B and G encompass a single inventive concept. Specifically, the invention of Groups A provides cycloalkyl urea compounds wherein various pharmacophores are linked with alkylene group(s). Likewise, the invention of Group B provides cycloalkyl urea compounds wherein various pharmacophores are linked with alkylene group(s). Similarly, the invention of Group G provides methods of using cycloalkyl urea compounds wherein various pharmacophores are linked with alkylene group(s). Accordingly, the Applicants have amended the claims to be more specifically directed to methods of using these cycloalkyl urea compounds, currently classified as Group 2. Applicants believe that any search for the compounds of the invention, specifically 1-adamantan-1-yl-3-(12-dodecanoic acid)-urea, will provide materials relating to methods of using the compounds. Thus, Applicants believe that prosecution of the currently amended claims, would not place a serious

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Prel. Amdt and Resp. to Restr. Rqmt. dated March 28, 2006

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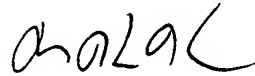
burden on the Office sufficient to justify restrictions. Reconsideration of the application is respectfully requested in view of the above remarks.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for substantive review on their merits.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 925-472-5014.

Respectfully submitted,



Mark H. Hopkins, Ph.D.
Reg. No. 44,775

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 925-472-5000
Fax: 415-576-0300
Attachments
M3H:dmd
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